

REMARKS

Favorable reconsideration of the subject application is respectfully requested in view of the above amendments and the following remarks. Claims 9-24, and 27-28 are pending. Claims 9, 12, 15, 16, 17, 20, 23, 24, 27, and 28 have been amended for clarification. Support for the amendments can be found throughout the instant specification. The amendments are not to be construed as acquiescence with regard to the Action's rejections and are made without prejudice to prosecution of any subject matter removed or modified by amendment in a related divisional, continuation, or continuation-in-part application. No new matter has been added to the application.

Rejection under 35 U.S.C. § 112, Second Paragraph

Claims 9-24, 27, and 28 stand rejected under 35 U.S.C. § 112, second paragraph as allegedly being indefinite. In particular, the Action has suggested alternative phrases where the claims were allegedly unclear.

Applicants traverse this ground for rejection and submit that the claims particularly point out and distinctly claim the subject matter which Applicants regard as the invention. However, solely to expedite prosecution and without acquiescing to the rejection, Applicants have amended claims 9, 12, 15, 16, 17, 20, 23, 24, 27, and 28 for clarification, and essentially as suggested by the Examiner. Thus, Applicants submit this ground for rejection has been overcome and respectfully request this rejection be withdrawn.

Rejection under 35 U.S.C. § 102(b), First Rejection

Claims 9-12, 14, 15, 17-20, 22, and 23 stand rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Breeuwer et al. (Applied and Environ. Microbiology 60(5): 1467-1472 (May 1994)). The Action alleges Breeuwer et al. disclose a method for detecting cell viability using flow cytometry.

Applicants respectfully traverse this ground for rejection and submit the presently claimed invention is not anticipated by Breeuwer et al. Applicants submit that a claim is

anticipated only if each and every element of the claim is found expressly or inherently in a single prior art reference. Applicants submit Breeuwer et al. disclose a method for determining the metabolizing capacity (vitality) of a yeast cell population, and do not disclose the presently claimed method of determining both viable and total cell count (viable and non-viable cells) in a sample. Applicants further submit Breeuwer et al. state, "At present, no satisfactory rapid method for determination of yeast viability...exists." See page 1467, first column. Applicants submit Breeuwer et al. do not disclose a method for detecting or quantitating the number of viable cells compared to total cell count in a cell sample, as claimed in the present invention. Thus, the presently claimed invention is not anticipated by Breeuwer et al. and accordingly, Applicants respectfully request the rejection be withdrawn.

Rejection under 35 U.S.C. § 102(b), Second Rejection

Claims 9, 11, 12, 14, 16, 17, 19, 20, 22, 24, 27, and 28 stand rejected under 35 U.S.C. 102(b) as allegedly being anticipated by Sarkadi et al. (U.S. Pat. No. 6,277,655). In particular, the Action alleges Sarkadi et al. disclose a method and kit for detecting viability of cells using calcein AM dye and fluorometer detection.

Applicants respectfully traverse this ground for rejection and submit the presently claimed invention is not anticipated by Sarkadi et al. Applicants submit a claim is anticipated only if each and every element of the claim is found expressly or inherently in a single prior art reference. Applicants submit Sarkadi et al. disclose a method for measuring multi-drug resistance protein function in tumor cells, but do not disclose detecting or quantitating viable cells compared to total cell count as in the presently claimed invention. Applicants further submit the method of Sarkadi et al. measures only viable cells that also possess active multi-drug resistance membrane proteins, thus viable cells that do not possess the multi-drug resistance membrane proteins will not be detected in the Sarkadi et al. method disclosed. Accordingly, Applicants respectfully request this rejection be withdrawn.

Rejection under 35 U.S.C. § 103(a)

Claims 13 and 21 stand rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over Breeuwer et al. (Applied and Environ. Microbiology 60(5): 1467-1472 (May 1994) or Sarkadi et al. (U.S. Pat. No. 6,277,655) in view of Katz (U.S. Pat. No. 3,586,859). The Action concedes neither Breeuwer et al., nor Sarkadi et al. disclose the element of the presently claimed invention of determining total cell count using UV absorption measurement. The Action alleges Katz discloses detecting total cell count by UV absorption and one of ordinary skill in the art would have combined Katz with Breeuwer et al. and Sarkadi et al. to arrive at the claimed invention.

Applicants respectfully traverse this ground for rejection and submit the presently claimed invention is not obvious in light of the cited references. Applicants submit the Action fails to establish a *prima facie* case of obviousness because nothing in the cited references provides the desirability or motivation for one of skill in the art to combine the relevant teachings in the cited references in order to arrive at the presently claimed invention.

Applicants submit, as previously set forth, neither Breeuwer et al., nor Sarkadi et al. disclose the presently claimed invention of detecting or quantitating viable cells compared to total cell count. Applicants submit further that Katz does not remedy this deficiency, since Katz discloses a method of detecting non-viable (dead) cells using a microscope coupled to a photomultiplier attached to an electronic reader, then heat-killing all cells followed by a second measure of the total number of dead cells. Applicants submit the presently claimed invention detects viable cells, and it would not have been obvious to one of ordinary skill in the art at the time of the present invention to combine the cited references to arrive at the presently claimed invention.

Additionally, while the Action interpreted the claims as allegedly being unclear, Applicants submit the claims have been amended for clarification with regards to the cited references. Applicants submit this rejection has been overcome and respectfully request the rejection be withdrawn.

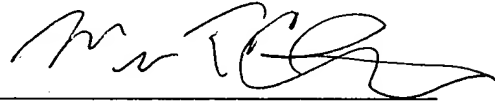
The Commissioner is authorized to charge any additional fees due by way of this Amendment, or credit any overpayment, to our Deposit Account No. 19-1090.

Application No. 09/912,266
Reply to Office Action dated March 13, 2003

All of the claims remaining in the application are now believed to be allowable.
Favorable consideration and a Notice of Allowance are earnestly solicited.

Respectfully submitted,

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